

Attorney Docket No. DOGO.P012

REMARKS

Claims 1-12 are pending in the application. Claims 1-12 are rejected. Claims 8, 9, and 12 have been amended herein. No new material is added by these amendments.

5 **Claim Rejections under 35 U.S.C. §101**

Claims 8-9, and 12 were rejected under 35 USC § 101, as being directed to non-statutory subject matter. The Board of Patent Appeals and Interferences (the "BPAI") recently evaluated the technological-arts rejection and found it inconsistent with existing federal law. As a result of the Patent Appeal Board's decision in *Ex parte Lundgren*,
10 Appeal No. 2003-2088 (Bd. Pat. App. & Inter. 2005), the Patent Office has stated that it will no longer reject patent applications based on a technological-arts requirement.

In light of the above, Applicants disagree with the assessment that claims 8-9, and 12 are directed to non-statutory subject matter and the rejection is in conflict with current Patent Office mandate regarding a technological arts requirement and 35 USC § 101.

15 Additionally, claims 8-9, and 12 recite elements which respectively provide a concrete, useful, and tangible result as required by 35 USC § 101. For example, claim 8 specifically recites "generating the difference file including the encoded differences and the encoded information of the first type of difference", which when viewed in the context of claim 8, clearly provides a concrete, useful, and tangible result. Claim 12
20 specifically recites "generating a difference file including the encoded differences and the encoded information of the first type of difference", which when viewed in the context of claim 12, also clearly provides a concrete, useful, and tangible result. However, to expedite the case, Applicants have amended claims 8-9, and 12. Applicants respectfully request removal of this rejection.

Attorney Docket No. DOGO.P012

Rejections under 35 U.S.C. §102

Claims 1-12 were rejected under 35 U.S.C. § 102(e) as being anticipated by Multer et al. (United States Patent No. 6,694,336), hereinafter "Multer". Applicants respectfully submit that the claims are patentably distinct from Multer.

5 An anticipation rejection requires that the cited reference, here Multer, teach each and every element of the rejected claim(s). As discussed below, it is clear that Multer does not teach each and every element of claims 1-12. Regarding claim 1, Multer does not disclose a system for updating electronic files of remote devices which includes a first device including a file differencing engine that generates differences between an original 10 version and a new version of an electronic file by identifying a first type of difference between the original and the new versions, generating a modified version of the original version using information of the first type of difference, generating encoded differences between the modified version and the new version, wherein the encoded differences include a second type of difference between the original and the new versions, encoding 15 the information of the first type of difference, generating a difference file including the encoded differences and the encoded information of the first type of difference, and a file updating engine hosted on the remote device, the file updating engine generating a copy of the new version using the difference file.

20 Multer does not anticipate claim 1. For example, Multer does not disclose a difference engine for generating a modified version of the original version of an electronic file using information of a first type of difference as required by claim 1.

The Office Action at page 3, paragraph 4, refers to column 4, lines 13-18 of Multer for support that Multer teaches a file differing engine that generates a modified version of the original version using information of the first type of difference.

25 Applicants do not see such support. At column 4, lines 13-18, Multer discloses:

30 "A further method of the invention comprises a method for updating data files in a system. The method includes the steps of receiving first change transactions for a subset of said data files; applying said change transactions to said subset of said data files subsequent to a change in said data files, generating second change transactions for said file;"

Attorney Docket No. DOGO.P012

The above citation by the Office Action does not provide sufficient evidence to show that Multer discloses a difference engine for generating a modified version of the original version using information of the first type of difference as required by claim 1.

As further example, Multer does not disclose a difference engine for generating 5 encoded differences between the modified version and the new version of an electronic file as required by claim 1.

The Office Action at pages 3-4, paragraph 4, refers to column 4, lines 17-19 of Multer for support that Multer teaches a file differing engine that generates encoded differences between the modified version and the new version. Again, Applicants do not 10 see such support. Applicants have included the disclosure of line 16, since starting from line 17 begins mid-sentence. At column 4, lines 16-19, Multer discloses:

15 "applying said change transactions to said subset of said data files subsequent to a change in said data files, generating second change transactions for said file; and outputting said second change transactions to an output."

The above citation by the Office Action does not provide sufficient evidence to show that Multer discloses a difference engine for generating encoded differences between the modified version and the new version of an electronic file as required by claim 1. While Applicants believe there are further examples of the deficient teaching of 20 Multer with respect to claim 1, the examples discussed above are sufficient to satisfy a showing that Multer fails to disclose each and every element of claim 1.

For at least these reasons, Applicants respectfully submit that claim 1 is not anticipated by Multer.

As claims 2-5 depend from claim 1 and include further limitations thereon, and 25 since claim 1 is not anticipated by Multer, Applicants submit that claims 2-5 are not anticipated by Multer.

Regarding claim 6, Multer does not disclose an apparatus for generating difference files, comprising means for identifying a first type of difference between an original file and a new file, wherein the new file includes an updated version of the 30 original file, means for generating a modified version of the original file using

Attorney Docket No. DOGO.P012

information of the first type of difference, means for generating encoded differences between the modified version and the new file, wherein the encoded differences include a second type of difference between the original and the new files, means for encoding the information of the first type of difference, and means for generating a difference file 5 including the encoded differences and the encoded information of the first type of difference.

Multer, in addition to other deficiencies, fails to disclose a means for generating a modified version of the original file using information of the first type of difference. Moreover, Multer fails to disclose a means for generating encoded differences between 10 the modified version and the new file. The insufficient disclosure of Multer as to similar limitations are discussed above in conjunction with claim 1, and are not repeated here.

For at least these reasons, Applicants respectfully submit that claim 6 is not anticipated by Multer.

As claim 7 depends from claim 6 and includes further limitations thereon, and 15 since claim 6 is not anticipated by Multer, Applicants submit that claim 7 is not anticipated by Multer.

Regarding amended claim 8, Multer does not disclose a method for generating difference files using a processor-based system, comprising receiving an original file and a new file, wherein the new file includes an updated version of the original file, 20 identifying a first type of difference between the original file and the new file, generating a modified version of the original file using information of the first type of difference, generating encoded differences between the modified version and the new file, wherein the encoded differences include a second type of difference, encoding the information of the first type of difference, and generating the difference file including the encoded 25 differences and the encoded information of the first type of difference.

Regarding claim 10, Multer does not disclose a method for updating electronic files hosted on remote systems, comprising receiving an original file and a new file, wherein the new file includes an updated version of the original file, identifying a first type of difference between the original file and the new file, generating a modified

Attorney Docket No. DOGO.P012

version of the original file using information of the first type of difference, generating encoded differences between the modified version and the new file, wherein the encoded differences include a second type of difference, encoding the information of the first type of difference, generating a difference file including the encoded differences and the
5 encoded information of the first type of difference, and updating a hosted copy of the original file in the remote systems using the difference file.

Regarding amended claim 12, Multer does not disclose a computer readable storage medium including executable instructions which, when executed in a processing system, generate a difference file that includes coded differences between an original file
10 and a new file by receiving the original and the new file, wherein the new file includes an updated version of the original file identifying a first type of difference between the original file and the new file, generating a modified version of the original file using information of the first type of difference, generating encoded differences between the modified version and the new file, encoding the information of the first type of
15 difference, and generating a difference file including the encoded differences and the encoded information of the first type of difference.

Multer, in addition to other deficiencies, fails to disclose the method as claimed in claims 8 and 10, and the computer readable storage medium of claim 12, including the limitations of generating a modified version of the original file using information of the first type of difference, and generating encoded differences between the modified version and the new file. The deficient teachings of Multer as to similar limitations are discussed above in conjunction with claims 1 and 6, and are not repeated here.
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For at least these reasons, Applicants respectfully submit that amended claim 8, claim 10, and claim 12 are not anticipated by Multer.

25 As claim 9 depends from claim 8 and includes further limitations thereon, and since claim 8 is not anticipated by Multer, Applicants submit that claim 9 is not anticipated by Multer.

Attorney Docket No. DOGO.P012

As claim 11 depends from claim 10 and includes further limitations thereon, and since claim 10 is not anticipated by Multer, Applicants submit that claim 11 is not anticipated by Multer.

Conclusion

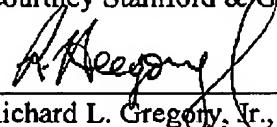
5 In view of the foregoing Remarks, Applicants respectfully submit that the rejections under 35 U.S.C. §101, and §102 have been overcome, and their withdrawal is respectfully requested. Applicants submit that claims 1-12 are in condition for allowance. The allowance of the claims is earnestly requested. If in the opinion of Examiner Ahluwalia a telephone conference would expedite the prosecution of the 10 subject application, or if there are any issues that remain to be resolved prior to allowance of the claims, Examiner Ahluwalia is encouraged to call Rick Gregory at (408) 342-1900.

Authorization to Charge Deposit Account

15 Please charge deposit account 503616 for any fees due and not paid herewith in connection with this Office Action response.

Respectfully submitted,
Courtney Staniford & Gregory LLP

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Richard L. Gregory, Jr., Reg. No. 42,607
Tel. (408) 342-1900

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Courtney Staniford & Gregory LLP
10001 N. De Anza Blvd. Ste 300
Cupertino, CA 95014
Fax: (408) 342-1909